

REMARKS

In the Office Action, the Examiner rejected claims 1-52 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Publication No. 2007/0021111 to Celik et al. ("the '111 publication")¹.

As a preliminary matter, Applicants note that in the Office Action mailed July 9, 2007, the Examiner applied U.S. Patent Application Publication No. 2005/0149487 to Celik ("the '487 publication") in a 35 U.S.C. § 102(e) rejection of claims 1-52 (Office Action mailed July 9, 2007, at p. 2). In the Reply to that Office Action, which was filed September 26, 2007, Applicants traversed the rejection under the '487 publication for similar reasons as discussed herein with respect to the '111 publication.

I. The Office Action Has Not Established That the '111 Publication is Prior Art Against the Claims of This Application

The '111 publication has a filing date of September 28, 2006, which is later than Applicants' filing date of November 24, 2003. The '111 publication is one of a series of continuation-in-part applications (CIPs) claiming priority to U.S. Patent Application No. 09/223,129, filed on December 30, 1998.

Of the applications in the priority chain disclosed on the face of the '111 publication, only two were filed before Applicants' filing date of November 24, 2003. Application No. 09/223,129 was filed December 30, 1998, and is now U.S. Patent No.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

6,374,259 ("the '259 patent"). Application No. 10/657,757 was filed September 8, 2003 as a continuation of Application No. 09/223,129, and is now U.S. Patent No. 7,296,036 ("the '036 patent").

As the '111 publication and the remaining applications on the face of the '111 publication are all CIP applications filed after Applicants' filing date, there is necessarily new matter present in each of these CIP applications that does not qualify for the priority date of the '259 and '036 patents.

According to 37 C.F.R. § 1.104(c), the "pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." It is not apparent what subject matter disclosed in the '111 publication qualifies for the priority date of the '259 and '036 patents. Accordingly, the Examiner has the initial burden to show the pertinence of this reference in rejecting claims 1-52, which includes identifying the subject matter relied upon by the Examiner in the rejections that is not new matter. The Examiner has not met this burden.

II. The Prior Art Does Not Teach or Suggest All the Elements of the Claims

To properly anticipate Applicants' claimed invention under 35 U.S.C. § 102(e), each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Further, "[t]he identical invention must be shown in as complete detail as is contained in the...claim." See M.P.E.P. § 2131 (8th Ed., Aug. 2001), quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131 (8th Ed. 2001), p.

2100-69. Applicants traverse the rejection of claims 1-52 under 35 U.S.C. § 102(e) for the following reasons.

As discussed, the '111 publication contains new matter which cannot be used against the claims of this application. Applicants therefore provide remarks distinguishing the '259 patent.

A. Claims 1-8

Claim 1 recites, for example, a method comprising "providing a notification, via a user terminal, of an incoming call initiated by a calling party and directed to a communication device." The '259 patent fails to teach or suggest at least the claimed notification.

The '259 patent discloses methods and apparatus for storing and retrieving business contact information in a computer system ('259 patent, abstract). The '259 patent also discloses retrieving contact information corresponding to an identification number contained in a request from a user ('259 patent, col. 5, lines 1-8). However, the '259 patent does not disclose retrieving contact information by providing a notification of an incoming call. Therefore, the '259 patent fails to teach or suggest the claimed "providing a notification, via a user terminal, of an incoming call initiated by a calling party and directed to a communication device," as recited by independent claim 1.

Because the '259 patent does not teach or suggest the claimed "providing a notification, via a user terminal, of an incoming call initiated by a calling party and directed to a communication device," the '259 patent cannot anticipate or render

obvious claim 1. Claims 2-8 depend from claim 1, and are allowable at least due to their dependence from allowable base claims.

B. Claims 9-17, 25-28, and 29-33

Claim 9 recites, for example, a method comprising "providing access to a contact source, the contact source including at least one listing representing a communication between the user and a second party." The '259 patent fails to teach or suggest at least the claimed listing.

As discussed, the '259 patent discloses methods and apparatus for storing and retrieving business contact information in a computer system ('259 patent, abstract), and retrieving contact information corresponding to an identification number contained in a request from a user ('259 patent, col. 5, lines 1-8). However, the '259 patent does not disclose retrieving contact information by accessing a listing representing a communication between a user and a second party. Therefore, the '259 patent fails to teach or suggest the claimed "providing access to a contact source, the contact source including at least one listing representing a communication between the user and a second party," as recited by independent claim 9.

Because the '259 patent does not teach or suggest the claimed "providing access to a contact source, the contact source including at least one listing representing a communication between the user and a second party," the '259 patent cannot anticipate or render obvious claim 9. Independent claims 25, 29, and 33, although of different scope than claim 1 and from each other, recite subject matter similar to that discussed above with respect to claim 9, and not taught or suggested by the '259

patent. Claims 10-17 depend from claim 9, claims 26-28 depend from claim 25, and claims 30-32 depend from claim 29, are allowable at least due to their dependence from allowable base claims.

C. Claims 18-24

Claim 18 recites, for example, a method comprising "obtaining contact-related information associated with the contact using information included in the communications log." The '259 patent fails to teach or suggest at least the claimed communications log.

As discussed, the '259 patent discloses methods and apparatus for storing and retrieving business contact information in a computer system ('259 patent, abstract), and retrieving contact information corresponding to an identification number contained in a request from a user ('259 patent, col. 5, lines 1-8). However, the '259 patent does not disclose a communications log used to obtain contact-related information. Therefore, the '259 patent fails to teach or suggest the claimed "obtaining contact-related information associated with the contact using information included in the communications log," as recited by independent claim 18.

Because the '259 patent does not teach or suggest the claimed "obtaining contact-related information associated with the contact using information included in the communications log," the '259 patent cannot anticipate or render obvious claim 18. Claims 19-24 depend from claim 18, and are allowable at least due to their dependence from allowable base claims.

D. Claims 34-52

Claim 34 recites, for example, a method comprising "detecting a change in the obtained contact-related information associated with the party by searching a plurality of network-based resources for information" (emphasis added). The '259 patent fails to teach or suggest at least this subject matter of claim 34.

As discussed, the '259 patent discloses methods and apparatus for storing and retrieving business contact information in a computer system ('259 patent, abstract), and retrieving contact information corresponding to an identification number contained in a request from a user ('259 patent, col. 5, lines 1-8). The '259 also discloses synchronizing contact information for a first user in a personal information manager (PIM) for a second user ('259 patent, col. 10, lines 11-22). However, the '259 patent does not disclose detecting a change in contact information by searching a plurality of network-based resources when synchronizing the PIM. Therefore, the '259 patent fails to teach or suggest the claimed "detecting a change in the obtained contact-related information associated with the party by searching a plurality of network-based resources for information," as recited by independent claim 34.

Because the '259 patent does not teach or suggest the claimed "detecting a change in the obtained contact-related information associated with the party by searching a plurality of network-based resources for information," the '259 patent cannot anticipate or render obvious claim 34. Claims 35-52 depend from claim 34, are allowable at least due to their dependence from allowable base claims.

III. Conclusion

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 

Walter D. Davis, Jr.
Reg. No. 45,137